



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,951	01/10/2001	Francois - Xavier Nuttall	11245.00053	1267

7590 11/04/2003

Squire, Sanders & Dempsey L.L.P.  
Two Renaissance Square  
Suite 2700  
40 North Central Avenue  
Phoenix, AZ 85004-4424

EXAMINER
----------

CHEUNG, MARY DA ZHI WANG

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/757,951

**Applicant(s)**

NUTTALL, FRANCOIS - XAVIER

**Examiner**

Mary Cheung

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-43 is/are pending in the application.
- 4a) Of the above claim(s) 40-43 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22,23,38 and 39 is/are allowed.
- 6) ☒ Claim(s) 9-13,17-21,24-30 and 34-37 is/are rejected.
- 7) ☒ Claim(s) 14-16 and 31-33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Status of the Claims***

1. Claims 9-43 are pending. Claims 9-39 have been elected without traverse. Claims 40-40 belong to non-elected group; thus, they are withdrawn from consideration. Claims 9, 17, 21, 23, 26, 29, 34 and 37 have been amended.

### ***Response to Arguments***

2. Applicant's arguments filed September 5, 2003 have been fully considered but they are not persuasive.

Applicant argues that Ginter does not teach receiving the first report in response to a transaction that provided the digital work because the report in Ginter's teaching is received prior to delivery of the digital work. Examiner believes there is no clear indication that the report in Ginter's teaching occurs prior to delivery of the digital work. Instead, Ginter teaches generating reports based on the user's usage of the digital work (column 56 lines 8-10).

In response to the applicant's argument that Ginter does not teach receiving a second report from a content managing node, this matter is taught by Ginter as receiving a report from a Financial Clearinghouse and VDE Administrator Node. In particular, Ginter states "the financial clearinghouse 116 may provide reports and/or payments to the distributor 106" (column 53 lines 61-63).

In response to the applicant's arguments that Ginter does not teach the step of comparing at the reconciling node, examiner believes that the corresponding matter is taught by Ginter as the VDE Rights Distributor provides the payments and the payment

Art Unit: 3621

related information to its corresponding content creator because verification or comparison step is an essential process prior to deliver of the payment.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 9-13, 17-21, 24-30 and 34-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al., U. S. Patent 5,910,987.

As to claim 9, Ginter teaches a method for managing accessing to a digital work, the method for execution by a reconciling node (is interpreted as Information Utility in Figure 1 or VDE Rights Distributor in Figure 2), the method comprising (abstract and Figs. 1-2):

a) Receiving at the reconciling node via a network a first report, the first report being provided in response to a transaction that provided the digital work from a content providing node to a content requesting node, the first report comprising a transaction identifier, the transaction conducted in response to a request originated by the content requesting node is taught by Ginter as receiving at the VDE Rights Distributor node a first report, the first report tracks the usages of the digital works provided from VDE Content Creator node to VDE Content User

Art Unit: 3621

node, the transaction conducted in response to a request originated by the content requesting node (column 55 line 48 – column 56 line 16 and Fig. 2);

b) Receiving at the reconciling node via the network a second report that originated from a content managing node in response to supplying by the content managing node information to validate the request, the second report comprising a value and a payee identifier is taught by Ginter as receiving at the VDE Rights Distributor node a second report that originated from a Financial Clearinghouse and VDE Administrator node in response to supplying by the Financial Clearinghouse and VDE Administrator node to validate the request, the second report comprising payments and payment related information (column 53 lines 60 – column 56 line 18 and Fig. 2);

c) Comparing at the reconciling node the value and the transaction identifier is taught by Ginter as the VDE Rights Distributor provides the payments and the payment related information to its corresponding content creator (column 53 lines 63-64 and Fig. 2);

d) Transmitting from the reconciling node onto the network a message enabling a credit to an account corresponding the payee identifier, transmitting being in response to comparing is taught by Ginter as the VDE Rights Distributor provides the payments and the payment related information to its corresponding Content Creator node (column 53 lines 63-64 and Fig. 2).

As to claim 10, the first report comprises indicia of a difference, the difference prepared in accordance with a start report originating from the content requesting node

Art Unit: 3621

and a summary report originating from the content requesting node is taught by Ginter as the first report tracks the usages of contents provided to the VDE Content User node (column 56 lines 8-16 and Fig. 2).

As to claim 11, receiving via the network a plurality of records, and determining the first report in accordance with a record of the plurality are taught by Ginter as tracking the usages of contents provided to the VDE Content User node (column 56 lines 8-16 and Fig. 2).

As to claim 18, Ginter teaches a memory device comprising indicia of the method of claim 9 (column 17 lines 60-67).

Claims 12-13, 17, 19-21 and 24-30 and 34-37 are rejected for the similar reason as claims 9-11 and 18.

### ***Allowable Subject Matter***

5. Claims 14-16 and 31-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 22-23 and 38-39 are allowed.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 3621

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

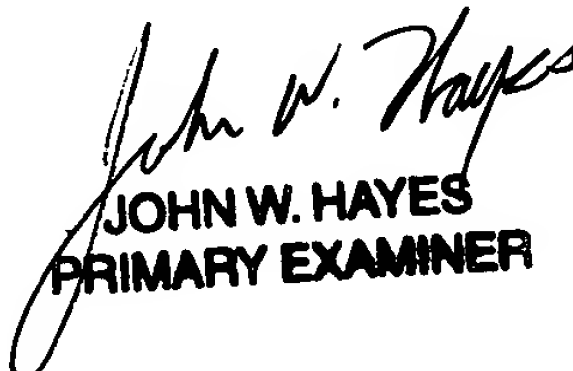
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 305-7687      (Official Communications; including After Final  
Communications labeled "BOX AF")  
(703) 746-5619      (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7<sup>th</sup> Floor Receptionist.

Mary Cheung  
Patent Examiner  
Art Unit 3621  
November 2, 2003

  
**JOHN W. HAYES**  
**PRIMARY EXAMINER**